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09/749,059	12/27/2000	James M. Proper	D/A0433Q	5636

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EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
1723	6

DATE MAILED: 08/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/749,059	Applicant(s)
	Examiner Charles Cooley	Art Unit 1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 Jun 2002

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1, 3-11, and 14-19 is/are pending in the application.

4a) Of the above, claim(s) 15-19 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3-11, and 14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims 1, 3-11, and 14-19 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s).

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s).

6) Other:

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OFFICE ACTION

Election/Restriction

1. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged.

The traversal is on the ground(s) that the groups are related to keep them in the same application and no undue burden is placed upon the PTO.

This is not found persuasive because with regard to apparatus claims versus method claims, in apparatus claims the material or article worked upon does not limit apparatus claims and is not a major consideration when determining the patentability of said apparatus claims (MPEP 2115). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). In stark contrast thereto, in method claims the materials on which a process is carried out must be accorded weight in determining the patentability of a process. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974) and see MPEP 2116. Accordingly, unlike the elected apparatus claims, patentable weight must be given to the claimed materials set forth in the pending nonelected method claims which significantly alters

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the search strategy and amplifies the searching required which leads to a significant burden on the PTO.

Applicant has not set forth any compelling reasons why the groups are not distinct from each other as set forth by the examiner in Paper No. 4. Applicant merely concludes that the apparatus and method claims are not properly restrictable because they are related and no undue burden exists for the PTO which are not compelling reasons to withdraw a restriction requirement. The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 15-19 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to this final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

3. The use of various trademarks has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The abstract is acceptable.

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5. The title is acceptable.

Claim Rejections - 35 U.S.C. § 112, first paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The specification fails to support the language added to claims 1, 10, and 11 regarding "an axis of connection substantially different from both the x-axis and z-axis" as well as amended claim 3 in its entirety. The specification provides no guidance on the claimed "axis of connection" such as where the axis is located, what element(s) define said axis, the axis along which the connection is adjustable, etc. If the axis of connection purports to be the axis of connector 33 (e.g., the longitudinal axis thereof), then the subject matter of claim 3 would appear mutually exclusive to this definition as this axis is fixed (since the collision surface pivots about the connector) and clearly not adjustable. Accordingly, since it is unknown what constitutes "an axis of connection

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substantially different from both the x-axis and z-axis", claims 1, 3, 10, and 11 are deemed to involve new matter.

7. Claims 1, 3-11, and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 U.S.C. § 112, second paragraph

8. Claims 1, 3-11, and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second paragraph of 35 USC 112 requires a claim to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Under *In re Hammack*, 166 USPQ 204 (CCPA 1970) and *In re Moore*, 169 USPQ 236 (CCPA 1971), claims must be analyzed to determine their metes and bounds so that it is clear from the claim language what subject matter the claims encompass. This analysis must be performed in light of the applicable prior art and the disclosure. The definiteness of the claims is important to allow others who wish to enter the market place to ascertain the boundaries of protection that are provided by the claims. *Ex parte Kristensen*, 10 USPQ 2d 1701, 1703 (BPAI 1989). The pending claims fail to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention and are therefore of indeterminate scope/indefinite for the following reasons:

9. Words of degree often cause definiteness problems. See *Seattle Box Co. v Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573 (Fed. Cir. 1984). Whenever a word of degree impacts the interpretation of a claim, the specification must provide some standard for measuring that degree. One of ordinary skill in the art must be able to understand what is claimed when the claim is read in light of the specification. *Id.* In the instant application, there is no standard for measuring the scope of "substantially different from both the x-axis and z-axis" appearing in claims 1, 10, and 11 as amended. Therefore, one of ordinary skill in the art would be unable to determine what axes of connection are included or excluded by the claims since the metes and bounds of "substantially" are unknown. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 1, 10, and 11: "the plane of rotation" lacks positive antecedent basis. Furthermore, these claims recite that the plane of rotation defines a z-axis, however, it is unclear how a plane necessarily defines the axis being recited. It appears the z-axis

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as defined by the disclosure (one of an infinite number of axes which could be disposed in such a plane) lies in the plane of rotation defined by the center shank or rather the plane defined by the x-axis and z-axis as seen in Fig. 3.

Claims 1, 10, and 11: "the z-axis of rotation" lacks antecedent basis - the z-axis has not been established as being an axis of rotation. It appears the axis of rotation would be along the y-axis defined by a shaft inserted into locking fixture 32.

Claim 3 as amended appears technically incorrect as the adjustability of the collision surface appears to be in the y-z plane rather than along the y-axis since the axis of pivoting of the collision surface is fixed.

10. Each pending claim should be thoroughly reviewed such that these and any other informalities are corrected so the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph. The claims are being treated on the merits to the extent they are understood and considered definite.

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Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 3-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Krause et al. (USP 4,281,934).

The patent to Krause et al. (USP 4,281,934) discloses the recited blender tool rotatable in a plane of rotation, said plane having a z-axis (being defined as an axis along the length of the tool 14 in Fig. 4); the tool comprising a center shank 8 having an x-axis 44; the x-axis being orthogonal to the z-axis (as the x-axis 44 clearly forms a right angle with an axis including the length of the tool since the tool is disposed perpendicular to the center shank as can be seen in Figs. 2 and 4); a collision surface including a plate 14, 51 spaced from the center shank 8 (Fig. 4); a connector mechanism including an arm 15 and a fastener 52 for fixing the position of the plate 14, 51 in various positions; the connector mechanism having an "axis of connection" (along the length of 52) which is different from the x-axis and the z-axis; said axis of connection being adjustable (as the fastener 52 is movable along its axis) which can be

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deemed a y-axis which is orthogonal to the x-axis and the z-axis; and collision plates 14 proximate each ends of the shank 8 (Fig. 2).

13. Claims 1, 3-9, 11, and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jones (USP 739,422).

The patent to Jones (USP 739,422) discloses the recited blender tool and blending machine comprising a vessel 10 for holding material; a drive shaft 19 connected to a blender tool rotatable in a plane of rotation, said plane having a z-axis (defined along the depth of the tool in Figs. 2 or 3); the tool comprising a center shank 23 having an x-axis defined along the length of the center shank 23; the x-axis being orthogonal to the z-axis; a collision surface including a plate 25 spaced from the center shank 23; a connector mechanism including an arm 26 and a fastener 28 for fixing the position of the plate 25 in various positions; the connector mechanism having an "axis of connection" (along the length of 26) which is different from the x-axis and the z-axis; said axis of connection being adjustable (as the arm 26 is movable along its axis as the fastener 28 threads up and down the length of the arm 26) which can be deemed a y-axis which is orthogonal to the x-axis and the z-axis; and collision plates 25 proximate each ends of the shank 23 (Fig. 3).

14. Claims 1, 4-9, 11, and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Austin (USP 3,245,663).

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The patent to Austin (USP 3,245,663) discloses the recited blender tool (Fig. 7) and blending machine comprising a vessel 20 for holding material; a drive shaft 50 connected to a blender tool rotatable in a plane of rotation, said plane having a z-axis (defined along the length of the tool 104 in Fig. 7); the tool comprising a center shank 52 having an x-axis (the axis along the length of 52 in Fig. 3); the x-axis being orthogonal to the z-axis (as the x-axis along the length of 52 clearly forms a right angle with an axis including the length of the tool as can be seen in Figs. 3 and 7); a collision surface including a plate 108 spaced from the center shank (Fig. 7); a connector mechanism including an arm 112 and a fastener 120 for fixing the position of the plate 108 in various positions; the connector mechanism having an "axis of connection" (along the length of 120) which is different from the x-axis and the z-axis; and collision plates 108 proximate each ends of the shank 52 (Fig. 3).

Allowable Subject Matter

15. In view of the new matter and indefiniteness of the claims, no claims can be considered allowable.

Response to Amendment

16. Applicant's arguments with respect to the pending claims have been considered but are deemed to be moot in view of the new grounds of rejection necessitated by amendment.

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17. Applicant's arguments filed 13 JUN 2002 have been fully considered but they are not deemed to be persuasive.

Applicant is reminded that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Turning to the rejections of the claims under 35 U.S.C. § 102(b), it is noted that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892

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(1988); *RCA Corp. v. Applied Digital Data Sys.. Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of properties that are inherently possessed by the prior art reference. *Verdegaal Brothers Inc. v. Union Oil co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses each and every element set forth in the claim (*In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what Applicant is claiming, but only that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue), *SRI Intel v. Matsushita Elec. Corp. Of Am.*, 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

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With respect to the applied prior art under 35 U.S.C. § 102(b), the examiner has explicitly demonstrated how the references disclose each and every element set forth in the claims and how the pending claims read on the disclosures of the references, hence the rejections are considered proper.

Since the examiner can arbitrarily choose the recited axes within the broad scope of the claims, the axes defined in the art rejections are considered to meet the particular axes recited in the claims. Since the examiner has shown equivalency between the recited axes and structure of the pending claims with the prior art, the rejections are considered proper. Unless Applicant chooses to appeal, it would perhaps be beneficial to Applicant to focus the claimed invention on the structure which allows pivoting of the collision surface in the y-z plane (with said plane being shown in Fig. 3 and the pivoting movement exemplified by Figs. 4-5) rather than the ambiguous quagmire that the pending claims find themselves submerged in. Note that at least the applied prior art above fails to show such structure which permits a pivoting movement or adjustability in the height (y) and depth (z) planes of the blending tool.

Applicant discusses such concepts as torque forces, impact forces, management of torque forces and it is not seen how such concepts would further define apparatus claims over the prior art, however, in any event, such arguments are of no patentable consequence because it is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982).

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Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

Limitations not found in the language of a claim cannot be read into the claim. *E. I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988). Limitations appearing in the patent specification cannot be read into the claims. *Id.* Nor is it permissible to inject into claims limitations referred to in the prosecution history. *Intervet America, Inc. v. Kee-Vet Labs, Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, (Fed. Cir. 1989).

In conclusion, the amendments made in the instant application are not deemed of a substantive nature to define over the prior art and thus the rejections are considered proper.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

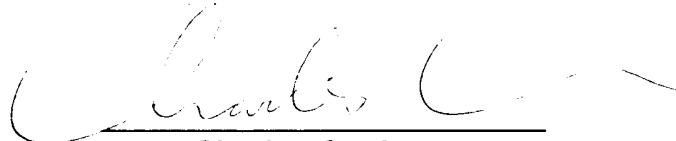
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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. **ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.**

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is **(703) 308-0112**.

20. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is **(703) 308-0651**.

Dated: **15 August 2002**



**Charles Cooley
Primary Examiner
Art Unit 1723**